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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,619	02/20/2004	Timothy M. Corcoran	149887	4142
38598	7590	01/08/2009		
ANDREWS KURTH LLP 1350 I STREET, N.W. SUITE 1100 WASHINGTON, DC 20005			EXAMINER SHEER, CRISTINA O	
			ART UNIT 3685	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/781,619

Applicant(s)

CORCORAN ET AL.

Examiner

CRISTINA OWEN SHERR

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed October 9, 2008. Claims 1, 2, and 5 are currently amended. Claims 1, 2, 5, and 8 are currently pending in this case. Claims 3-4, 6-7 and 9-20 had been previously canceled.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 9, 2008 has been entered.

Response to Arguments

3. Applicant's arguments with respect to the claims, as currently amended, have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy, II et al (US 6,240,295).

6. Kennedy discloses an information clearinghouse ("clearinghouse" fig 1-22), comprising: a system having a central information repository ("platform" col 4 ln 25-40) wherein information

related to transactions is processed and stored, the repository, comprising: a processor section including routines to operate the clearinghouse (e.g. col 4 ln 40-55), a transaction section that tracks transactions recorded in the clearinghouse, and a data section that records the information and provides an interface to users of the clearinghouse (e.g. col 4 ln 56-65, col 6 ln 1-10, col 6 ln 28-32); and a set of rules for operation of the clearinghouse (e.g. col 4 ln 40-55).

7. Note that Kennedy discloses a clearinghouse for information regarding transactions such that transactions are tracked by means of the information relating to them. Kennedy discloses an information clearinghouse ("clearinghouse" fig 1-22), comprising: a system having a central information repository ("platform" col 4 ln 25-40) wherein information related to various transactions (in the case of the instant application it is transactions with respect to transportation of goods, in Kennedy the transactions have to do with cell phone usage, nevertheless they are both tracking information regarding transactions) wherein information is processed and stored, the repository, comprising: a processor section including routines to operate the clearinghouse (e.g. col 4 ln 40-55), a transaction section that tracks transactions recorded in the clearinghouse, and a data section that records the information and provides an interface to users of the clearinghouse (e.g. col 4 ln 56-65, col 6 ln 1-10, col 6 ln 28-32); and a set of rules for operation of the clearinghouse (e.g. col 4 ln 40-55). It is obvious to one of ordinary skill in the art that a clearinghouse tracks transactions via information thereon, what type of transaction is moot, further it is obvious to use such a clearinghouse to track any type of transactions, whether related to transportation of goods or any other type of transaction. KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

8. A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform. MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987). In this case, the clearinghouse of Kennedy, like most clearinghouses, has the capability of tracking transactions, whether it happens that such transaction have to do with transportation of good or not, does not further distinguish the claim from the prior art.

9. Regarding claim 5 –

10. Kennedy discloses an Information Clearinghouse (“clearinghouse” fig 1-22); comprising: a set of rules for operation of the clearinghouse system (e.g. col 4 ln 40-55).

11. As above, note that Kennedy discloses a clearinghouse for information regarding transactions such that transactions are tracked by means of the information relating to them. Kennedy discloses an information clearinghouse (“clearinghouse” fig 1-22), comprising: a system having a central information repository (“platform” col 4 ln 25-40) wherein information related to various transactions (in the case of the instant application it is transactions with respect to transportation of goods, in Kennedy the transactions have to do with cell phone usage, nevertheless they are both tracking information regarding transactions) wherein information is processed and stored, the repository, comprising: a processor section including routines to operate the clearinghouse (e.g. col 4 ln 40-55), a transaction section that tracks transactions recorded in the clearinghouse, and a data section that records the information and provides an interface to users of the clearinghouse (e.g. col 4 ln 56-65, col 6 ln 1-10, col 6 ln 28-32); and a set of rules for operation of the clearinghouse (e.g. col 4 ln 40-55). It is obvious to one of ordinary skill in the art that a clearinghouse tracks transactions via information thereon, what

type of transaction is moot, further it is obvious to use such a clearinghouse to track any type of transactions, whether related to transportation of goods or any other type of transaction. KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. KSR, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

12. A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform. MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987). In this case, the clearinghouse of Kennedy, like most clearinghouses, has the capability of tracking transactions, whether it happens that such transaction have to do with transportation of good or not, does not further distinguish the claim from the prior art.

13. Regarding claim 8 –

14. Kennedy discloses a method for operation of an Information Clearinghouse ("clearinghouse" fig 1-22), comprising: providing a clearinghouse system including a central information repository ("platform" col 4 ln 25-40); providing a set of rules for operating the clearinghouse system(e.g. col 4 ln 40-55); and monitoring compliance with the adopted rules. (e.g. col 7 ln 4-18).

15. As above, note that Kennedy discloses a clearinghouse for information regarding transactions such that transactions are tracked by means of the information relating to them. Kennedy discloses an information clearinghouse ("clearinghouse" fig 1-22), comprising: a system having a central information repository ("platform" col 4 ln 25-40) wherein information related to various transactions (in the case of the instant application it is transactions with respect to transportation of goods, in Kennedy the transactions have to do with cell phone usage,

nevertheless they are both tracking information regarding transactions) wherein information is processed and stored, the repository, comprising: a processor section including routines to operate the clearinghouse (e.g. col 4 ln 40-55), a transaction section that tracks transactions recorded in the clearinghouse, and a data section that records the information and provides an interface to users of the clearinghouse (e.g. col 4 ln 56-65, col 6 ln 1-10, col 6 ln 28-32); and a set of rules for operation of the clearinghouse (e.g. col 4 ln 40-55). It is obvious to one of ordinary skill in the art that a clearinghouse tracks transactions via information thereon, what type of transaction is moot, further it is obvious to use such a clearinghouse to track any type of transactions, whether related to transportation of goods or any other type of transaction. *KSR* forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

16. A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform. MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987). In this case, the clearinghouse of Kennedy, like most clearinghouses, has the capability of tracking transactions, whether it happens that such transaction have to do with transportation of good or not, does not further distinguish the claim from the prior art.

17. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of "Farmer's Mutual Benefit Association".

18. Regarding claim 2 –

19. Kennedy discloses as discussed above.

20. Mutual benefit associations are old and well-known. See, e.g. "Farmer's Mutual Benefit Association" (http://en.wikipedia.org/wiki/Farmers'_Mutual_Benefit_Association). Such associations include different entities which may or include both private and public sector entities, and they propose or make up rules to be followed by all of them. See also <http://delcode.delaware.gov/title18/c055/index.shtml>.

21. KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness. KSR, 127 S.Ct. at 1741, 82 USPQ2d at 1396. Further, Applicants are merely taking known elements and combining them to obtain a predictable result.

Remarks

22. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

23. In this case, in claim 1, we find that a system is an apparatus. Tracking transportation of goods rather than tracking anything else, and using rules acknowledged by a government agency rather than anyone else, refer to what the apparatus does rather than what it is. Such features, therefore, do not serve to further distinguish the claims from the prior art.

24. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is

respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA OWEN SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.
26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRISTINA OWEN SHERR
Examiner
Art Unit 3685

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Examiner, Art Unit 3685

